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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,759	01/24/2000	Brian B. Flippini	2942R/B	7598

7590

04/22/2003

The Lubrizol Corporation  
Patent Administrator  
2900 Lakeland Boulevard  
Wickliffe, OH 44092

EXAMINER
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TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 04/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/490,759

Applicant(s)

FLLIPPINI ET AL.

Examiner

Cephia D. Toomer

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-25 is/are rejected.
- 7) ☒ Claim(s) 26-33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5,6,8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

This Office action is in response to the amendment filed February 4, 2003 in which claims 1, 11, 23 and 24 were amended and claims 2 and 3 were canceled.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 4-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorer (US 4,613,342).

Dorer teaches a fuel composition comprising a reaction product of a hydrocarbyl substituted carboxylic acylating agent (succinic acid or anhydride) with one or more amines or hydroxyamines, one or more alcohols, or a mixture of one or more amine and alcohol (see abstract). The hydrocarbyl group contains from 8 to 30 carbon atoms (see col. 16, lines 65-68; col. 17, lines 38-54). The hydroxyamines, amines and alcohols are the same as those of the present invention (see col. 20, lines 36 through col. 36, lines 1-25).

In Examples 2 and 5, Dorer prepares the acylating agent. In claims 3 and 6, Dorer reacts the acylating agent with a polyamine where 11 and 17 parts of water are removed, respectively. See also Examples 8, 9, 14 and 15. Dorer

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teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Dorer differs from the claims in that he does not specifically teach that the amount of water separated from the reaction is from 0.2 - 0.9 moles or from 1.2 to 1.9 moles. However, given the proportion of water removed in the reactions of Examples 3 and 5, it is the examiner's position that the proportions of water removed in Dorer are within the scope of the present invention, absent evidence to the contrary.

In the second aspect, Dorer differs from the claims in that he does not specifically teach the total acid number of the composition. However, it would be reasonable to expect that the composition of Dorer would possess the claimed total acid number given that Dorer uses the same reactants and produces a similar product.

Applicant argues that Dorer fails to teach or suggest a hydrocarbyl group wherein the range of the hydrocarbyl group is 12 to 24 carbon atoms. Applicant argues that Dorer teaches hydrocarbyl groups that have 30 or more carbon atoms.

Dorer does teach using hydrocarbyl groups of 30 carbon atoms or more. However, also teaches that the hydrocarbyl group may be mono-olefins of from about 8 to about 30 carbon atoms (see abstract; col. 16, lines 65-68 and col. 17, lines 38-54).

Claims 26-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the

limitations of the base claim and any intervening claims. The prior fails to teach or suggest the claimed emulsion, fuel, lubricant or acidizing fluid containing the partially dehydrated product of claim 1.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

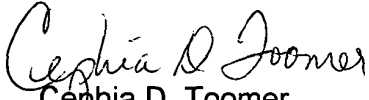
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

09490759\10

April 21, 2003

  
Cephia D. Toomer  
Primary Examiner  
Art Unit 1714